

Appl. No.: 10/009,453
Grp /A.U. 1617

REMARKS/ARGUMENTS

Favorable consideration and allowance of the instant application is respectfully requested in view of the following remarks.

Claims 9-20 are pending in this application.

Claim 9 has been amended. No new matter is thought to be introduced thereby.

The Examiner's rejections, as they pertain to the patentability of the claims, are respectfully traversed.

The disclosure is objected to due to a typographical error found in the last line on page 27. The typographical error has been corrected.

Claims 9-20 are rejected under 35 U.S.C. § 112, second paragraph. This rejection is respectfully traversed for the following reasons.

The terms "enhanced" and "enhancing" in claims 9 and 15 are deemed indefinite. Claim 9 has been amended in order to delete the objected-to term. However, with regards to claim 15, since the objected-to term is present in the preamble of the claim, it is not believed to render the claim indefinite.

Accordingly, for all of the above-stated reasons, reconsideration and withdrawal of this rejection is respectfully requested.

Claims 9, 10, 12-16 and 18-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US 5,939,079. This rejection is respectfully traversed for the following reasons.

Initially, Applicant would like to note that in order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 based upon a single reference, the Office must show an art-recognized motivation to modify the reference in the manner asserted by the Office. See, *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the instant case, the Examiner bases her conclusion of obviousness on the '079 references teaching that metal soaps having a particle size of less than 10 μm may be used as a filler in its dispersion.

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While the Examiner acknowledges that this reference fails to teach the claimed particle size of from about 10 to 100 nm, the Examiner attempts to overcome this lack of teaching by shifting the burden of proof unto Applicant to show why it would not, via mere optimization, be obvious to employ metal soap nanoparticles having the claimed particle size.

In response thereto, Applicant would like to note that the burden is on the Patent Office to establish *prima facie* obviousness against a claimed invention. The fact remains that the '079 reference fails to teach or suggest the use of nanoparticles having the claimed particle size. The difference between the particle size taught by the '079 reference, i.e., less than 10 μm versus the claimed range, is significant to say the least. The Examiner has failed to provide any evidence of motivating force in support of her conclusion that it would be obvious to employ nanoparticles having the claimed range of particle size. Instead, the Examiner relies upon the argument that it would be obvious to optimize '079's range to read on the claimed range and then attempts to shift the burden on Applicant to prove otherwise.

It is extremely well settled in the law that the mere allegation that the differences between the claimed subject matter and the prior art are obvious does not create a presumption of unpatentability which forces an Applicant to prove conclusively that the Patent Office is wrong. See, *In re Soli*, 137 USPQ 797 (CCPA 1963). The ultimate legal conclusion of obviousness must be based on facts or records, not on the Examiner's unsupported allegation that a particular modification is known, or easily discoverable by routine experimentation, and therefore obvious. Subjective opinions are of little weight in determining obviousness. See, *In re Wagner et al*, 152 USPQ 552 (CCPA 1967).

Applicant respectfully submits that the Examiner's conclusion of obviousness is based on an impermissible "obvious to try" rationale. It is well settled that where the prior art gives either no indication as to which parameters are critical or no direction as to which

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of many possible choices is likely to be successful, prima facie obviousness may not be based on an improper "obvious to try" rationale. See, In re O'Farrell, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988). Clearly, such is the case here.

Accordingly, for all of the above-stated reasons, reconsideration and withdrawal of this rejection is respectfully requested.

Claims 11 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the '079 reference as applied above to claims 9, 10, 12-16 and 18-20, and further in view of US 2,456,437. This rejection is respectfully traversed for the following reasons.

The '437 reference is relied upon for its teaching regarding the use of organic material to coat soap particles. The problem with its teaching, however, is that it is silent with respect to the potential for using organic materials to coat **inorganic** soap particles such as the claimed **metal** soap particles. The only soap particles referred to by this reference, which are coated with its organic coating material, are sodium soaps of fatty acids. Thus, even if a person of ordinary skill in the art had both the '079 and '437 references in front of them, they would not necessarily be motivated to apply the organic material of the '437 reference onto the metal soaps of the '079 reference since there is no teaching or suggestion that this can be successfully done. Moreover, there is no teaching or suggestion in either reference that the problem addressed by the '437 reference, i.e., dust particles, is also a problem experienced by metal soaps. Thus, in Applicant's opinion, the use of the organic materials of the '437 reference on the metal soaps of the '079 reference is far from obvious.

Finally, in view of the shortcomings associated with the '079 reference, i.e., its lack of teaching, suggestion or **motivation** to employ inorganic nanoparticle fillers possessing the claimed particles, is as outlined above, even if these two references were combined, as is suggested by the Examiner, their combined teachings would nevertheless fail to render the claimed invention prima facie obvious.

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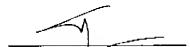
Accordingly, for all of the above-stated reasons, reconsideration and withdrawal of this rejection is respectfully requested.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned **"Version with markings to show changes made."**

It is believed that the foregoing reply is completely responsive under 37 CFR 1.111 and that all grounds for rejection are completely avoided and/or overcome. A Notice of Allowance is therefore earnestly requested.

The Examiner is requested to telephone the undersigned attorney if any further questions remain which can be resolved by a telephone interview.

Respectfully submitted,


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Enc.: Version With Markings To Show Changes Made

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

The last line on page 27 (under Table 2 (continued)) has been amended as follows:

(21-25) foam bath, (26) soft cream, (27,28) moisturizing emulsion, (29,[20] 30) night cream --

In the Claims:

Claim 9 has been amended as follows:

9. (First amended) A composition comprising:

- (a) an active ingredient selected from the group consisting of a cosmetically-active ingredient, a pharmaceutically-active ingredient, and mixtures thereof; and
- (b) metal soap nanoparticles having a mean diameter of from about 10 to 300 nm[, and wherein the composition possesses enhanced stability, opacity and consistency properties].